

ESTTA Tracking number: **ESTTA498552**

Filing date: **10/05/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	El Encanto, Inc.
Granted to Date of previous extension	10/06/2012
Address	2001 4th Street SW Albuquerque, NM 87102 UNITED STATES
Attorney information	Ashley Krause Brownstein Hyatt Farber Schreck, LLP 410 Seventeenth Street, Suite 2200 Denver, CO 80202 UNITED STATES akrause@bhfs.com, dnipdocket@bhfs.com Phone:303.223.1248

### Applicant Information

Application No	85556144	Publication date	08/07/2012
Opposition Filing Date	10/05/2012	Opposition Period Ends	10/06/2012
Applicant	Hatch Chile Company, Inc. 2003 S. Commercial Drive Brunswick, GA 31525 UNITED STATES		

### Goods/Services Affected by Opposition

Class 029. First Use: 1988/07/30 First Use In Commerce: 1988/07/30 All goods and services in the class are opposed, namely: Processed jalapenos, processed green chile, green chile stew, processed tomatoes and green chile, processed tomatoes and jalapenos, snack mix consisting primarily of processed peanuts, processed almonds, sesame sticks and seasonings
Class 030. First Use: 1992/12/31 First Use In Commerce: 1992/12/31 All goods and services in the class are opposed, namely: Sauces, namely, salsa and taco sauce; enchilada sauce

### Grounds for Opposition

The mark is primarily geographically descriptive	Trademark Act section 2(e)(2)
The mark is primarily geographically deceptively misdescriptive	Trademark Act section 2(e)(3)
Other	breach of agreement between the parties

Related	1. Opposition No. 91204917 and 2. Opposition against Application No.
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Proceedings	85556157 filed October 5, 2012
Attachments	Opposition 85556144.pdf ( 10 pages )(251410 bytes )

### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/ashleykrause/
Name	Ashley Krause
Date	10/05/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of the Trademark Application Serial No. 85/556144  
For the Trademark: HATCH (Stylized) in International Classes 29 & 30  
Published in the Official Gazette on August 7, 2012

El Encanto, Inc. d/b/a Bueno Foods,  
Opposer,

v.

Hatch Chile Company, Inc.,  
Applicant.

**OPPOSITION NO.** \_\_\_\_\_

**NOTICE OF OPPOSITION**

El Encanto, Inc. d/b/a Bueno Foods ("Bueno"), a New Mexico corporation having its principal place of business at 2001 4th Street SW, Albuquerque, New Mexico 87102, believes it will be damaged by the registration of U.S. Trademark Application Serial No. 85/556144 for the mark HATCH (Stylized) (the "Application") filed by Hatch Chile Company, Inc. ("HCC"), and therefore opposes the same.

As grounds for the opposition, Bueno alleges as follows:

**A. The Parties**

1. Bueno is a successful food company based in New Mexico that produces New Mexican and Mexican style foods.
2. Bueno manufactures, prepares, and distributes more than 150 authentic, gourmet-quality food products to restaurants, grocery stores and other retail customers throughout the United States. Bueno's products include green chile, red chile, salsas, and a line of ready-to-

serve prepared products such as tamales and enchiladas. Certain of Bueno's products are sourced from the Hatch Valley in New Mexico.

3. For years, Bueno – like many other New Mexico-based food producers – has used the descriptive term "Hatch" in connection with the description and promotion of certain food products that are sourced from New Mexico's Hatch Valley, and Bueno intends to continue such use.

4. HCC is a food company based in Brunswick, Georgia. Upon information and belief, HCC manufactures and distributes food products to restaurants and grocery stores throughout the United States.

5. Upon information and belief, an individual named Steve Dawson is the president of HCC.

6. Upon information and belief, in one of his prior employment positions, Mr. Dawson served as the president of Hatch Farms, Inc. ("Hatch Farms"), the predecessor entity to HCC.

7. On February 29, 2012, HCC filed the Application, claiming use of the alleged mark HATCH (Stylized) in connection with certain food products. As amended, the Application claims use of the alleged mark HATCH (Stylized) in connection with "processed jalapenos, processed green chile, green chile stew, processed tomatoes and green chile, processed tomatoes and jalapenos, snack mix consisting primarily of processed peanuts, processed almonds, sesame sticks and seasonings" in class 29, and "sauces, namely, salsa and taco sauce; enchilada sauce" in class 30 (collectively, the "HCC Products").

**B. The Meaning of the Term "Hatch"**

8. Hatch, New Mexico is a village located in Doña Ana County, New Mexico.

9. The Hatch Valley is the area surrounding Hatch, New Mexico.

10. The Hatch Valley is known among the relevant consuming public for its chile and other New Mexican food products that originate from that area.

11. In certain trademark registrations owned by HCC (U.S. Reg. Nos. 1735090, 1735053, and 1722215), HCC has disclaimed the term "Hatch," thereby acknowledging that "Hatch" is a descriptive term.

**C. The "Hatch" Agreement**

12. In or around 1991, Mr. Dawson and Hatch Farms entered into an agreement with Bueno regarding the use of the term "Hatch" (the "Agreement"). A copy of the Agreement is attached as Exhibit A.

13. Pursuant to Paragraph 2 of the Agreement, Mr. Dawson and Hatch Farms agreed to "never use the word 'HATCH,' or assert exclusive rights to the word 'HATCH,' as a trademark for chile or trade name for a business that grows or deals in chile," except as part of a combination "with a design or with another word or words or with both words and design."

14. Paragraph 2 of the Agreement expressly applies to, among others, Mr. Dawson, Hatch Farms, and "their subsidiaries, affiliates, successors, and associate companies," as well as Mr. Dawson "acting directly or indirectly through any business enterprises."

15. The Agreement was executed by Mr. Dawson, both in his individual capacity and his capacity as president of Hatch Farms.

**FIRST GROUND FOR OPPOSITION**

16. The alleged mark HATCH (Stylized) is primarily geographically deceptively misdescriptive under Section 2(e)(3) of the Lanham Act, 15 U.S.C. § 1052(e)(3).

17. The primary significance of the term "Hatch" is as a generally known geographic location: the Hatch Valley in New Mexico, which includes the village of Hatch, New Mexico.

18. The consuming public is likely to believe that the place identified by the alleged mark HATCH (Stylized) indicates the origin of the HCC Products (that is, that a goods/place association exists).

19. Upon information and belief, the HCC Products – or at least a portion of the HCC Products – do not come from the Hatch Valley.

20. HCC's misrepresentation through its use of the alleged mark HATCH (Stylized) with the HCC Products is a material factor in the relevant public's decision to purchase the HCC Products.

21. If HCC's alleged mark is permitted to register, HCC will obtain at least a prima facie exclusive right to use the term "HATCH" in certain contexts, thereby endangering Bueno's right to continue using the term "Hatch" in its own commercial efforts. In addition, Bueno and the purchasing public will be damaged by HCC's registration of the alleged mark HATCH (Stylized) for the HCC Products as a result of HCC's deceptive misrepresentation through the use of the alleged mark.

22. In light of the foregoing, the Board should refuse registration of the Application pursuant to Section 2(e)(3) of the Lanham Act, 15 U.S.C. § 1052(e)(3).

#### SECOND GROUND FOR OPPOSITION

23. As an alternative to the First Ground for Opposition set forth above, the alleged mark HATCH (Stylized) is primarily geographically descriptive under Section 2(e)(2) of the Lanham Act, 15 U.S.C. § 1052(e)(2).

24. The primary significance of the term "Hatch" is as a generally known geographic location: the Hatch Valley in New Mexico, which includes the village of Hatch, New Mexico.

25. The consuming public is likely to believe that the place identified by the alleged mark HATCH (Stylized) indicates the origin of the HCC Products (that is, that a goods/place association exists).

26. If HCC's alleged mark is permitted to register, HCC will obtain at least a prima facie exclusive right to use the term "HATCH" in certain contexts, thereby obscuring Bueno's right to continue using the term "Hatch" in its own commercial efforts.

27. In light of the foregoing, the Board should refuse registration of the Application pursuant to Section 2(e)(2) of the Lanham Act, 15 U.S.C. § 1052(e)(2).

### THIRD GROUND FOR OPPOSITION

28. The Agreement remains in full force and effect.

29. HCC, and its president, Mr. Dawson, are bound by terms of the Agreement.

30. The Agreement prohibits HCC and/or Mr. Dawson from using or asserting exclusive rights in the alleged mark HATCH (Stylized) in connection with the HCC Products.

31. By filing the Application, HCC has asserted exclusive rights in the alleged mark HATCH (Stylized) in connection with the HCC Products, in breach of the Agreement.

32. The Agreement precludes and/or estops HCC from registering and use of the alleged mark HATCH (Stylized) in connection with the HCC Products.

33. As a result of HCC's attempt to claim trademark rights in the term "Hatch" and register and use the alleged mark HATCH (Stylized) in contravention of the terms of the Agreement, Bueno has suffered and will continue to suffer damage to its business.

### **D. Conclusion**

WHEREFORE, Bueno respectfully requests that U.S. Trademark Application Serial No. 85/556144 be rejected, that no registration be issued thereon to HCC, and that this opposition be

sustained in favor of the opposer, El Encanto, Inc. d/b/a Bueno Foods.

Respectfully submitted,

Dated: October 5, 2012

By:



Bruce L. Plotkin

Ashley Krause

Brownstein Hyatt Farber Schreck, LLP

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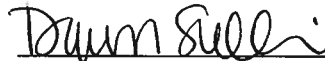
akrause@bhfs.com

ATTORNEYS FOR OPPOSER

**CERTIFICATE OF SERVICE**

I, Dawn Sullivan, hereby certify that on October 5, 2012, I served the foregoing Notice of Opposition upon the following person(s) via U.S. mail:

Kevin Lynn Wildenstein  
Southwest Intellectual Property Services  
9400 Holly Ave., NE Bldg. 4  
Albuquerque, NM 87122-2969

  
Dawn Sullivan, Paralegal  
Brownstein Hyatt Farber Schreck, LLP  
410 Seventeenth Street, Suite 2200  
Denver, CO 80202

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EXHIBIT

A

AGREEMENT

EL ENCANTO, INC., a New Mexico corporation, and HATCH FARMS, INC., a New Mexico corporation, agree:

1. The parties agree that the word "HATCH" as used in connection with chile is a geographically descriptive term and when the word "HATCH" is used in connection with chile, prospective purchasers expect the chile to come from the Hatch Valley in New Mexico.

2. The parties agree that they, their subsidiaries, affiliates, successors and associate companies, and Steve Dawson ("Dawson"), acting directly or indirectly through any business enterprises, may use a combination of the word "HATCH" with a design or with another word or words or with both words and design as a trademark for chile or a trade name for a business that deals in chile and may assert exclusive rights in the combination, so long as the combination is not likely to be confused with a prior trademark or trade name of the other party. The parties and Dawson will never use the word "HATCH," or assert exclusive rights to the word "HATCH," as a trademark for chile or trade name for a business that grows or deals in chile, except as part of such a combination. The parties and Dawson are free to use the word "HATCH" as a geographically descriptive term in connection with chile.

3. El Encanto agrees that it will withdraw its application for registration, Serial No. 73/727,882, filed on

May 12, 1988, in the U.S. Patent and Trademark Office, or cancel the registration if it issues, in a form agreed to by both parties; provided, however, that El Encanto may reapply for registration of the logo which was the subject of that application or registration upon changing the logo to include the "BUENO" trademark and reducing the size and prominence of the word "HATCH" in or outside of the logo so that the word "BUENO" is prominently featured in the logo and on the label. In its application, El Encanto will disclaim exclusive rights to use the word "HATCH" apart from the mark. Hatch Farms, Inc., and Dawson agree they will not oppose or seek cancellation of registration of such mark, nor will they encourage or assist others in doing so.

4. Hatch Farms, Inc., may seek registration for its HATCH SELECT mark in connection with its green chile products in the U.S. Patent and Trademark Office, provided it disclaims exclusive rights to use the word "HATCH" apart from its HATCH SELECT mark. Likewise, Hatch Farms, Inc., may seek registration for its HATCH SELECT mark in connection with its non-chile containing products in the U.S. Patent and Trademark Office, and shall not be required, under this Agreement, to disclaim the word "HATCH" as it pertains to such products. El Encanto agrees it will not oppose or seek cancellation of registration of such marks, nor will it encourage or assist others in doing so.

5. This Agreement binds the parties, their successors and assigns, may not be modified except in writing signed by the

parties, and will be governed by and construed according to the laws of the State of New Mexico.

HATCH FARMS, INC.

EL ENCANTO, INC.

By Steve Dawson  
Its PRESIDENT

By Jose L. [illegible]  
Its [illegible]

I agree to the provisions of paragraphs 2 and 3.

Steve Dawson  
STEVE DAWSON